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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/318,353 05/25/99 CASAGRANDE

C 38916/14140

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EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722
DATE MAILED:

09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/318,353

Applicant(s)

Charles L. Casagrande

Examiner

Mark T. Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 4, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-12, 14-18, and 21-24 is/are rejected.

7) ☒ Claim(s) 13, 19, and 20 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8

20) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 2, 6, 7, 12 and 15 have been amended for further examination

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 2 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "adapted to" in claims 2 and 15 is a relative term which renders the claim indefinite. The term "adapted" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7, 9, 11, 12, 14, 16-18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al (5,662,976).

Popat et al discloses in Fig. 4 and 7, a form with integrated label comprising a form layer (60) having a top surface (A) and a bottom surface (62) and a periphery, at least one die cut (68

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and 70) through the top and bottom surfaces within the periphery of the form layer defining at least one portion (portion of 60 between 68 and 70) or card intermediate, a patch layer (80) divided by a perforation line (82), a periphery and composed of translucent material, top surfaces (80a) and bottom surface (80b), a layer of repositionable, peelable adhesive (58), wherein the bottom surface of the patch layer is adhesively but removably secured (due to release coating 64) to the top surface of the form layer over the entire die cut and form layer portion in which the patch layer, adhesive layer and form layer comprising an integrated label (as seen in Fig. 7). and wherein the adhesive layer has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer such that when the label (as seen in Fig. 7) is removed from the form, the portion of the adhesive layer (portion on left side of die cut 72 and left side of 68 as seen in Fig. 4) that is not between the patch layer and the form layer portion (portion of 60 between 68 and 70) is exposed and stays adhered to the bottom surface of the patch layer (this can also be seen in Fig. 3, top portion wherein when the label is lifted, the exposed adhesive can be seen around the die-cut perimeter). Popat also discloses a patch layer sized and offset in relation to the die cut in the form layer such that a distance between an edge (76A) of the patch layer and a corresponding edge of the form layer (70A) is greater than that between other corresponding edges.

However, Popat et al does not disclose: a patch layer composed of translucent paper glassine, translucent polyester film, opaque material; sized and offset in relation to the die cut in the form layer such that the distance between an edge of the patch layer and a corresponding edge

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of the form layer portion is less than that between other corresponding edges; the form layer contains multiple die cuts therein defining multiple portions of the form layer.

In regards to **Claims 1, 11, 12 and 24**, it would have been an obvious matter of design choice to construct a peelable label having a pressure sensitive adhesive attached to a release coating to make it removably attachable instead of the use of a repositionable material adhesive void of any release coatings, since applicant has not disclosed in the claims that the repositionable adhesive solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a pressure sensitive adhesive removable attached to a release coating on a form layer. Furthermore, it is noted that the features upon which applicant relies (i.e., a form void of releasing agents allowing for recycling of the form) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to **Claims 4-6, 17, 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer in any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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Furthermore in regards to **Claim 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to offset the patch layer and form layer at any distance, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Also in regards to **Claims 6 and 7**, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 9 and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of die cuts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

4. Claims 2, 10, 15, 21, 22, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Blum et al (4,204,706).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat also discloses the bottom surface (62) of the form layer being able to accept indicia.

However, Popat et al does not disclose the top surface of the patch layer and the top surface of the form layer being able to accept indicia.

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Blum et al discloses in Fig. 2 and Col. 3, lines 50-56, a form with integrated label having a patch layer (19) and a form layer (17) in which indicia can be accepted on the top surfaces thereof through the use of "spot carbonized" method, so that when marking pressure is applied to the outer top surface of the patch layer, a corresponding ink mark is produced on the top surface of the form layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include "spot carbonization as taught by Blum et al for the purpose of eliminating the requirement that the patch be folded back to permit marking of indicia on the form surface.

5. Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Stipek (3,914,483).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1 and as set forth above.

However, Popat does not disclose an integrated label containing a second label comprising portions of the patch within a second die cut extending through the patch layer and to, but not through the form layer portion, wherein the second label is removable.

Stipek discloses in Fig. 5 and 6, an integrated label (51) containing a second label (33) comprising portions of the patch and adhesive layers within a second die cut (53).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include a label within a label as taught by Stipek for the providing a way in which an inner label can be removed from the main label after it is affixed to a container with the inner label being easily attachable to containers.

Allowable Subject Matter

6. Claims 13, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on September 10, 2001 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Popat et al reference fails to disclose the use of repositionable adhesive material on the form "void of releasing agents allowing for recycling of the form", the examiner submits that it would have been an obvious matter of design choice to

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construct a peelable label having a pressure sensitive adhesive attached to a release coating to make it removably attachable instead of the use of a repositionable material adhesive void of any release coatings, since applicant has not disclosed in the claims that the repositionable adhesive solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a pressure sensitive adhesive removable attached to a release coating on a form layer. Furthermore, it is noted that the features upon which applicant relies (i.e., a form void of releasing agents allowing for recycling of the form) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

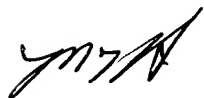
In response to applicant's arguments that the Popat et al reference fails to disclose a patch layer void of die cuts that leaves behind material upon removal of the card from the form, the examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer void of any die cuts that leaves behind material, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184. Furthermore, it would have been an obvious matter of design choice to construct the patch layer and form layer of any desirable size to eliminate any excessive material, since such a modification would have involved a mere change in the size of a

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component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 15, 2001



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